

Application No. 10/707,854
Amendment dated February 6, 2006
Reply to Office Action of January 30, 2006

Docket No.: 00131-00281-US1

REMARKS

Method claims 5-15 and product-by-process claim 16 remain pending in this application. Claim 5 is independent, and claim 16 is a multiply dependent product-by-process claim. Device claims 1-4 have been previously withdrawn as being directed to the non-elected invention. No claims have been added, amended, or canceled by this Response.

Anticipation Rejection over Murakowski et al.

Withdrawal of the rejection of claims 5-16 under 35 U.S.C. §102(e) as being anticipated by Murakowski et al. "Etchless Fabrication of Slaab Photonic Crystals in Silicon" is requested. This reference is not a proper §102 reference under any subpart of the statute.

35 U.S.C. §102(e) is NOT the Appropriate Statute

As previously, submitted, Murakowski et al. is not a proper reference or prior art under 35 U.S.C. §102, including 102(b).

With respect to this office action, Murakowski et al. is not a proper reference or prior art under 35 U.S.C. §102(e). A rejection under section 102(e) is appropriate only for *patents and patent publications* which meet certain filing and publication date requirements.

In particular, 35 U.S.C. §102 provides, in pertinent part (*emphasis added*):

- (e) the invention was described in
 - (1) *an application for patent*, published under section 122(b), *by another* filed in the United States before the invention by the applicant for patent or
 - (2) *a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent*, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the

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international application designated the United States and was published under Article 21(2) of such treaty in the English language...

Accordingly, since the Murakowski et al. is neither a published application for patent by another, nor a patent granted on an application for patent filed by another before the invention by the applicant, Murakowski et al. is not a proper §102(e) reference.

35 U.S.C. §102(a) is Also not the Appropriate Statute

As pointed out in the previous response, Murakowski et al. is also not a proper reference under §102(a) ("by another"). Murakowski et al. has a publication date of May 2002 (conference paper from CLEO Conference May 19-25, 2002), and has authorship that is identical to the inventorship of the present application.

The present application has an effective U.S. filing date of April 22, 2003, the filing date of Provisional Application 60/464,353, from which the present application claims benefit under 35 U.S.C. §119(e). This effective U.S. filing date is less than one year from the publication date of the applied art.

Therefore, the applied art is not prior art under § 102(a).

"Swearing Back" is Not Required

The Examiner offers the possibility that the Murakowski et al. reference could be overcome by an affidavit under 37 C.F.R. §1.132. Applicants submit that this is unnecessary because the Murakowski et al. reference is not a proper §102 reference under any subpart, as discussed above.

Conclusion

Accordingly, reconsideration and allowance of claims 5-16 are respectfully requested.

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In view of the above remarks, applicant believes that each of pending claims 5-16 in this application is in immediate condition for allowance.

The Examiner is authorized to cancel non-elected claims 1-4 by way of Examiner's Amendment accompanying any Notice of Allowability that might be issued in this application.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the undersigned attorney is available at the telephone number indicated below.

Applicants believe that no fee is due with this response. However, if a fee is due, please charge CBLH Deposit Account No. 22-0185, under Order No. 00131-00281-US1 from which the undersigned is authorized to draw.

Respectfully submitted,

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